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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,708	08/31/2001	Thomas Joseph Kelly	13DV14047	1769

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JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
3726	[REDACTED]

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/944,708	Applicant(s) KELLY ET AL.
	Examiner Marc Jimenez	Art Unit 3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM

THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 February 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 8-11 is/are rejected.
- 7) Claim(s) 6,7,12 and 13 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-5 and 8-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt (4,323,186) in view of King et al. (4,337,886).

Hunt teaches a method of manufacturing a welding filler metal (col. 1, lines 40-43), comprising the steps of: casting (col. 2, line 9) a nickel-base alloy (col. 4, lines 15-16) as an extrusion rod having a diameter from about 0.2 inch to about 0.5 inch (col. 5, line 48 and col. 2, line 25, Hunt specifically gives examples of .18 inch and 0.225 inch), the extrusion rod having grains in the cross section of the extrusion rod, and extruding the extrusion rod in a single extrusion operation (see figure and col. 5, lines 9-11) to a filler-metal diameter of less than about 0.1 inch (col. 2, line 66, Hunt specifically teaches a diameter of less than 0.07inch) and using an areal extrusion ratio of at least about 9:1 (col. 7, lines 28-31) to form the welding filler metal.

Hunt teaches the invention cited above with the exception of having at least about 12 grains in the cross section of the extrusion rod.

King et al. teach at least about 12 grains **12,12a** in the cross section of an extrusion rod.

Art Unit: 3726

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Hunt with at least about 12 grains in the cross section of the extrusion rod, in light of the teachings of King et al., in order to increase the malleability of the rod (as suggested by King et al. at col. 1, lines 56-60).

With respect to Claims 3 and 11, Hunt/King et al. teach the invention cited above with the exception of using the claimed materials.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have selected the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Regarding claims 2 and 10, Hunt teaches casting a nickel-based superalloy (col. 10, lines

4-8)

Regarding claims 4 and 5, Hunt teaches casting the nickel base alloy to an extrusion rod diameter of about $\frac{1}{4}$ inch (col. 2, lines 24-25, 0.225 inch is "about $\frac{1}{4}$ inch" in col. 5, line 48, 0.180 inch is "about $\frac{1}{4}$ inch") and extruding the extrusion rod to a diameter from about 0.05 to about 0.06 inch (col. 2, line 66, "0.07 inch and smaller").

Regarding claim 8, Hunt teaches an areal extrusion ratio of from about 9:1 to about 25:1 (col. 7, lines 28-31).

Application/Control Number: 09/944,708

Art Unit: 3726

Allowable Subject Matter

3. **Claims 6, 7, 12, and 13** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Applicant's arguments filed 2/18/03 have been fully considered but they are not persuasive.

5. Applicant argues that King teaches a cast rod and has no teaching that the cast rod is an extrusion rod that is therefore reduced in diameter by extrusion. However, King is relied on for teaching the particular grain cross section, specifically the claimed grain number (see 12 at fig. 1). Hunt teaches the claimed casting and then extrusion (col. 2, lines 9-13 or col. 2, lines 20-66) of the rod to reduce its diameter. Although King is not relied upon for teaching casting and then extruding, it is noted that King suggests in col. 1, lines 34-35 that wires can be "extruded into wires of the desired diameters". Furthermore, in col. 2, lines 3-8, King teaches that the object of the invention is to provide an improved **cast metal weld filler metal** which is malleable. A further object is to economically provide small diameter wires of normally **nonforgeable alloys**. A still further object is to provide **cast wires** which can be **drawn to smaller diameters**. In col. 2, lines 14-15 the process of King intends to create a structurally deformable malleable wire.

6. Regarding claims 3 and 11, Applicant's original disclosure does not show that the use of the claimed materials provides an advantage or produces unexpected results. Therefore, the original position that the use of the claimed materials is a matter of obvious design choice to a

Application/Control Number: 09/944,708

Art Unit: 3726

person of ordinary skill in the art at the time of the invention is maintained because the materials taught by Hunt and King et al. would work equally as well as the claimed materials utilized in the process.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Interviews After Final

8. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

Application/Control Number: 09/944,708

Art Unit: 3726

Contact Information

9. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to

CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is 703-306-5965. The examiner can normally be reached on **Monday-Thursday and the second Friday of the bi-week, between 9am-6pm.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Application/Control Number: 09/944,708

Art Unit: 3726

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line 1-800-786-9199
Internet PTO-Home Page <http://www.uspto.gov/>

MJ MJ
April 5, 2003

Greg Vidovich
GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700